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Beck & Tysver
Suite 100
2900 Thomas Avenue South
Minneapolis, MN 55416

EXAMINER

MARMOR II, CHARLES ALAN

ART UNIT PAPER NUMBER

3736

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/018,154

Applicant(s)

KAI, DESINGER

Examiner

Charles A. Marmor, II

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4,5,8,10,12-14,16-23 and 27-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12,13,17 and 18 is/are allowed.
- 6) ☒ Claim(s) 4,5,8,10,16 and 27-29 is/are rejected.
- 7) ☒ Claim(s) 14,16 and 19-23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is responsive to the Amendment filed December 5, 2005. The Examiner acknowledges the amendments to the Specification; the amendments to claims 4, 5, 8, 10, 12-14 and 16-23; the cancellation of claims 1-3, 6, 7, 9, 11, 15 and 24-26; and the addition of new claims 27-29. Claims 4, 5, 8, 10, 12-14, 16-23 and 27-29 are pending.

Drawings

2. The drawings were received on December 5, 2005. These drawings are acceptable.

Specification

3. The disclosure is objected to because of the following informalities:

- a. At page 7, lines 21 and 24, "Segments" should read --segments--.
- b. At page 13, line 17, the period following "10" apparently should be deleted.

Appropriate correction is required.

4. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

5. Claims 14, 16, 19, 23 and 29 are objected to because of the following informalities:
- a. At claim 14, line 3, "the peripheral" apparently should read --a peripheral--.
 - b. At claim 16, line 15, "the hollow" apparently should read --a hollow--.
 - c. At claim 19, line 14, "the surface" should read --a surface--.
 - d. At claim 19, line 16, "the adjoining" should read --adjoining--. Claims 20-22 are objected to as being allowable but dependent on a base claim that has been objected to.
 - e. At claim 23, line 3, "(10)" should be deleted.
 - f. At claim 29, line 2, "ot" should read --to--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 4, 5, 8, 10, 16 and 27-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, while the disclosure provides proper antecedent support for the claim terminology (see at least page 6, lines 10-15), it is unclear how a common guide element secured to both ends of the wire loop can be guided in a plurality of longitudinal grooves extending parallel to the longitudinal axis. In the disclosed embodiments of the invention having a common guide element secured to both ends of the wire loop, only a single longitudinal groove

is provided. Similar discrepancies result from the "is/are" limitation at line 4 of claim 10 and the limitation spanning lines 13-15 of claim 27.

Regarding claim 8, it is unclear which of the plurality of longitudinal grooves the limitation "adjacent to the longitudinal groove" is intended to refer to.

Claim 16 recites the limitation "the proximal opening" in lines 15-16. There is insufficient antecedent basis for this limitation in the claim. The probe is not disclosed as having a proximal opening prior to this recitation.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 27-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Ritchart et al. ('806). Ritchart et al. teach a surgical hollow probe for tissue removal. The probe (10) includes an elongate hollow body (12); a distal opening (14) at the distal end of the hollow body for receiving tissue; and an electrically conductive ring-shaped or loop-shaped cutting element (20). The cutting element (20) is adapted to be extended from or pivoted out of the hollow body transversely with respect to the longitudinal axis of the hollow body (column 8, lines 33-45). The cutting element is axially displaceable outside the hollow body along the hollow body. The

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cutting element is disposed in a plane that extends transversely with respect to the longitudinal axis and is displaceable in a parallel relationship to the longitudinal axis. The cutting element (20) is a flexible wire ring which is secured to a guide element (18) which is displaced through a longitudinal groove (16) along the hollow body. The distal opening (14) is arranged adjacent to the distal end of the longitudinal groove (16). The guide element (18) may be considered a thrust rod which is slidably and rotatably supported in the groove (16).

Allowable Subject Matter

10. Claims 12-14 and 17-23 are allowable over the prior art of record.
11. Claims 4, 5, 8, 10 and 16 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.
12. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claims 4, 5, 8 and 10, no prior art of record teach or fairly suggest a surgical hollow probe for minimally invasive tissue removal, as claimed by Applicant, where the cutting element is in the form of a wire loop whose ends are secured to at least one guide element which is slidably guided at the outside surface of the hollow body in a plurality of longitudinal grooves extending parallel to the longitudinal axis of the hollow body.

Regarding claim 12, no prior art of record teach or fairly suggest a surgical hollow probe for minimally invasive tissue removal, as claimed by Applicant, where a gap is provided in the peripheral wall of the hollow body at one end of the displacement travel of the cutting element,

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where the cutting element is adapted to extend from and retract into the hollow body through the gap.

Regarding claims 13-14, no prior art of record teach or fairly suggest a surgical hollow probe for minimally invasive tissue removal, as claimed by Applicant, where a closure is provided to open and close the distal opening.

Regarding claim 16, no prior art of record teach or fairly suggest a surgical hollow probe for minimally invasive tissue removal, as claimed by Applicant, where a separate suction air passage extends along the hollow body from a connection with a suction removal device in the longitudinal direction to the distal opening, and where the suction air passage is in communication over its entire length with the hollow passage of the hollow body via suction openings.

Regarding claim 17, no prior art of record teach or fairly suggest a surgical hollow probe for minimally invasive tissue removal, as claimed by Applicant, where the distal end of the probe converges to a point.

Regarding claim 18, no prior art of record teach or fairly suggest a surgical hollow probe for minimally invasive tissue removal, as claimed by Applicant, where an electrode is positioned on a surface of the hollow body in the region of the distal end that is connected to one terminal of a HF-voltage source that has a second terminal connected to the cutting element.

Regarding claims 19-23, no prior art of record teach or fairly suggest a surgical hollow probe for minimally invasive tissue removal, as claimed by Applicant, where axially-spaced first and second electrodes are positioned at a distal region of the hollow body.

Response to Arguments


13. Applicant's arguments filed December 5, 2005 have been fully considered but they are not fully persuasive. Applicant contends that the art rejections citing Ritchart et al. have been obviated and that new claims 27-29, which are allegedly analogous to at least claim 4, have been filed. Applicant's arguments are persuasive in that the 102(e) rejections have been withdrawn with respect to claims 4, 5, 8, 10, 12-14 and 16-23. However, a new ground of rejection under 35 U.S.C. 102(e) is set forth above citing Ritchart et al. with respect to the new claims 27-29. Ritchart et al. teaches a cutting element in the form of a wire loop whose ends are secured to a common guide element that is slidable at the outer surface of the hollow body in a longitudinal groove parallel to the longitudinal axis of the hollow body.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Marmor, II whose telephone number is (571) 272-4730. The examiner can normally be reached on M-TH (7:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Charles A. Marmor, II
Primary Examiner
Art Unit 3736

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February 21, 2006